



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,381	03/28/2001	Masaru Iwagaki	01165/LH	3744

1933 7590 07/16/2003

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
767 THIRD AVENUE
25TH FLOOR
NEW YORK, NY 10017-2023

EXAMINER

MATHEWS, ALAN A

ART UNIT PAPER NUMBER

2851

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,381

Applicant(s)

IWAGAKI ET AL.

Examiner

Alan A. Mathews

Art Unit

2851

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-12 and 14-19 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. (The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10-12, 14-16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Moghadam et al. (U. S. Patent No. 5,799,219). Moghadam et al. discloses in figures 1 and 2 and column 4, lines 1-23, a customer dropping off a recording medium 10 (film) at a shop 30 (order entry station). Column 4, lines 27, 45, and 45 disclose the customer providing the customer's Internet address. Providing the customer's Internet address would be a request. The customer could be the receiver, and thus, the customer's Internet address would be the receiver's address. The keyboard 32 would be used to input the address of the receiver. In addition, column 5, lines 47-50, disclose that the customer could authorize additional sites 80 for receipt of the electronic message and in turn the digital index prints 84. Figure 4 and column 4, lines 65-67, disclose a scanner 42 for converting the image or the recording medium into electronic image data. Column 5, lines 32-55 disclose transmitting an electronic image to the address of the receiver through the communication system including wire 72. Column 6, lines 21-23, disclose transmitting an electronic image to the customer's home using the Internet. With respect to claim 2, the additional information could be billing information (see the abstract, lines 26-29).

Art Unit: 2851

With respect to claim 16, figure 4 discloses a terminal 64 of the customer. The terminal of another party would occur when the customer authorized additional sites 80 for receipt of the electronic message and in turn the digital index prints 84.

3. Claims 10-12, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheridan (U. S. Patent No. 5,760,917). Sheridan discloses in figure 4 dropping off a recording medium 48 (film) at a shop. Scanner 6 converts the image of the recording medium into electronic image data. The electronic images are transmitted using connections 30. Figure 2 discloses providing addresses for receivers to which electronic image data are to be transmitted (see column 5, lines 7-41). Selecting access rights would be the same thing as providing addresses. The request is made when the customer drops of the recording medium 48.

Claim Rejections - 35 USC § 103

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al as applied to claim 10 above, and further in view of Garfinkle et al. (U. S. Patent No. 6,017,157). Moghadam et al. discloses the invention except for specifically disclosing eliminating image data when a predetermined time period has been elapsed. Garfinkle et al. discloses in column 5, lines 40-48, keeping the images on the image server for a fixed period of time, such as 30 days, after which they are marked as deleted and , after a short grace period (such as 5 days), removed from the image server to free up space. It would have been obvious at

the time the invention was made to a person having ordinary skill in the art to eliminate image data after a predetermined time period has been elapsed in view of Garfinkle et al. for the purpose of reducing the amount of memory needed by keeping image data indefinitely, and thus reducing cost.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al. Moghadam et al. discloses the invention except for specifically disclosing returning the recording medium to an address designated by the customer. It is old and well known to return negatives to the customer. In fact, the Examiner has received the negatives (recording medium) back from the developer for many decades. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to return the recording medium in Moghadam et al. in view of this old and well known concept for the purpose of giving the customer a permanent record of the film in case the customer wants reprints.

Allowable Subject Matter

6. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan A. Mathews whose telephone number is (703) 308-1706. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

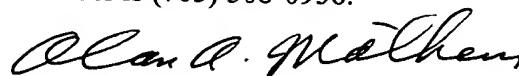
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (703) 308-2847. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Application/Control Number: 09/819,381

Page 6

Art Unit: 2851

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Alan A. Mathews
Primary Examiner
Art Unit 2851

AAM
July 1, 2003